

REMARKS

Claims 1-17, 19-25, 29-31, 33, 34, 38-40, 42-54, and 57-64 are in the case. Claims 6-17, 19-22, 48-54, 57, and 58 have been cancelled without prejudice or disclaimer. Claims 59-69 are added. It is believed that no fees are necessary for the new claims added, because the number of new claims added does not exceed the number of claims cancelled from the application. Also, the number of independent claims in the application has been reduced.

Claims 1-17, 19-25, 29-31, 33, 34, 38-40, 42-54, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Howarth (U.S. 6,908,636) or Howarth (U.S. 6,986,910) in view of Hilgren et al. (U.S. 6,514,556). Claims 6-17, 19-22, 48-54, 57, and 58 are cancelled; however, Applicant respectfully requests reconsideration of the remaining claims in light of the following remarks.

Regarding Claims 1, 2, 5/1, 5/2, 23-28, 34, 39, 40, 44, 45, 47/44, and 47/45, the Examiner fails to state a reason for the obviousness rejection. The Supreme Court has recently ruled in *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) that it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. 127 S.Ct. 1731. Specifically, the Court stated:

“Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, the analysis should be made explicit.” 127 S.Ct. at 1740-41.

Thus, in formulating an obvious rejection, it is necessary to explicitly state the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. The Examiner refers to “paragraph nos. 6-8, Paper No. 030606” as the reasoning for the obviousness rejection. *See* Office Action, Page 2, Item 2. However, paragraph no. 6 of Paper No. 030606 (the paragraph addressing the claims referenced above) discusses a 102(e) rejection relying on either Howarth reference and fails to explicitly state a reason why a person

of ordinary skill in the art would have combined the prior art elements in the manner claimed. Thus, the Examiner has failed to assert a *prima facie* case of obviousness and the Applicant respectfully requests that the rejection be withdrawn.

With respect to Claims 29, 33, 38, 42, 43/38, 42, 46, and 47/46, the Examiner again fails to state a reason for the obviousness rejection, and the argument presented above is reiterated here with equal force. As stated above, the Examiner refers to “paragraph nos. 6-8, Paper No. 030606” as the reasoning for the obviousness rejection. *See* Page 2, Item 2 of the present Office Action. However, paragraph no. 7 of Paper 030306 (the paragraph addressing the above mentioned claims) discloses an obviousness rejection of the referenced claims relying on the Howarth references only. There is no disclosure of the combination with Hilgren et al. to form an obviousness rejection and therefore no explicit reason stated as to why one of ordinary skill in the art would have combined the prior art elements in the manner disclosed. Thus, the Examiner has failed to assert a *prima facie* case of obviousness and the Applicant respectfully requests the rejection be withdrawn.

Regarding Claims 3, 4, and 5/3, 5/4, the Examiner states in paragraph no. 8 of Paper 030306 the following reason for the obviousness rejection:

It would have been obvious to perform the inside-outside washing in either Howarth patent by the procedure claimed by the applicant wherein a spray is used to treat the outside of the carcasses and a spray probe is used to treat the inside of the carcasses since such a procedure is well known in treating eviscerated poultry carcasses with a microbiocidal solution to reduce contamination thereof, as evidenced by Hilgren et al.

Although the Examiner has explicitly stated a reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed, Applicant respectfully asserts an error in such reasoning because the combination of the references would be illogical. The Examiner has relied on Hilgren et al. for the use of a spray probe, but has failed to consider the Hilgren et al. reference as a whole. The Federal Circuit has established that:

[I]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much as of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what a reference fairly suggests to one of ordinary skill in the art.

Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987). When taken as a whole, Hilgren et al. teaches way from combination with either of the Howarth references. Hilgren et al. discloses a preferred composition made by “mixing the carboxylic acid or mixture thereof with an optional hydrotrope solubilizer or coupler, reacting the *mixture* with hydrogen peroxide and then adding the balance of required ingredients to provide rinsing and antimicrobial action.” (Emphases added; column 15, lines 55-60). From this disclosure, it is apparent that Hilgren et al. requires a mixture prepared using a particular sequence of steps in forming the mixture that is the composition, and further, a reaction must occur to form the peroxycarboxylic acid (column 5, line 67 to column 6, line 4). This is in direct conflict with the Howarth references, which teach a solution requiring only one solute, which solute is not in any way related to those disclosed in Hilgren et al. The Howarth references do not require a mixture of substances or an *in situ* reaction to form the biocide therein, but instead disclose dissolving in water “at least one 1,3-dibromo-5,5-dialkylhydantoin” (Howarth '910, column 5, lines 20-25). A purpose of the invention as stated in either Howarth reference is to provide a “more effective, economically feasible way of providing microbiological control in the poultry processing industry.” *See* Howarth '636, column 2, lines 30-33 and Howarth '910, column 2, lines 34-36. By forming a mixture of several ingredients as in Hilgren et al., the efficiency of the poultry processing decreases.

Furthermore, Hilgren et al. teaches away from the use of chlorinated biocides, stating that [T]he use rate of these antimicrobials is very high because they are not effective at low concentrations or they tend to be rapidly consumed by the high organic load included with the poultry. Excessive chlorination of food processing water with hypochlorite has prompted concern over production of toxic or carcinogenic organochlorine compounds and other by-products. (Hilgren et al., column 2, lines 20-30.)

From this passage, it is clear that Hilgren et al. discourages the use of chlorine-based biocides. In contrast, Howarth teaches the use of chlorinated biocides, including chlorine, 1,3-dichloro-5,5-dialkylhydantoins, and 1,3-bromochloro-5,5-dialkylhydantoins, (column 2, line 47 to column 3, line 4). These teachings of Howarth contradict those of Hilgren et al., and it is thus submitted that the cited references teach away from their combination.

Still, in the Office Action mailed on January 29, 2007, it was asserted that Hilgren et al. merely discourages the use of *excessive chlorination* without discouraging use of chlorination altogether. (Office Action, page 2, paragraph 4, emphasis added.) However, when read as a whole, it is clear that the Hilgren et al. reference does not contemplate or suggest *any* use of chlorinated antimicrobials. Instead, it teaches a different composition or mixture of compositions as a *replacement* for chlorine-containing antimicrobials. In particular, in addition to the passage in Hilgren et al. at column 2, lines 20-30 (quoted above), another passage in Hilgren et al. that discusses chlorinated antimicrobial compositions appears at column 19, lines 42-46, which reads:

The advantageous stability of mixed peroxycarboxylic acid compositions in such methods, which include the presence of poultry debris or residue, makes these compositions *competitive with cheaper, less stable, and potentially toxic chlorinated compounds*. (Emphasis added.)

Read as a whole, it is clear that Hilgren et al. is not simply discouraging the use of “excess” chlorine-based compositions. Rather, Hilgren et al. is discouraging the use of chlorine-based compositions altogether, in favor of the compositions taught in Hilgren et al. Accordingly, the combination of the Howarth references with Hilgren et al. cannot be supported by a fair reading of the references read in their entirety. Hilgren et al. actually teaches away from the Howarth references (which teach the use of chlorine-containing biocides), and the attempt to combine their teachings to cobble together the present rejection is simply an improper use of hindsight reasoning, using the benefit of Applicant’s own disclosure to piece together a rejection of Applicant’s claims.

For all of the foregoing reasons, the combination of the references used to form the obviousness rejection is improper. Thus, Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully requests that the rejection be withdrawn.

With respect to Claims 59-69, these claims are new but add no new matter. Support for the addition of claim 59 may be found at least in paragraph [0022] of the Specification. Claim 60 is similar to Claim 1, but includes the feature “wherein said inside-outside washing is

conducted with a contact time of 60 seconds or less.” Support for this claim may be found at least in Table 4 of the Specification. Claim 61 depends from Claim 60 and includes the feature of the “microbiocidal solution of water treated with a microbiocidal amount of at least one 1,3-dibromo-5,5-dialkylhydantoin is utilized in said inside-outside washing within two hours of the formation of said solution.” Support for this amendment may be found at least in paragraph [0046] of the Specification. Claim 62 depends from Claim 60 and features the contact time from “30 to 60 seconds.” Support for this claim is found in Table 4 of the Specification. Claim 63 depends from Claim 62 and support for the addition of this claim may be found at least in Table 4 of the Specification and paragraph [0046].

Claim 64 depends from any of Claims 60-63 and includes the feature of “said at least one 1,3-dibromo-5,5-dialkylhydantoin consists essentially of 1,3-dibromo-5,5-dimethylhydantoin.” Support for this amendment may be found in at least paragraph [0031] of the Specification. Claim 65 depends from Claim 60 and includes the limitation of 1,3-dibromo-5,5-deimethylhydantoin and the contact time in a range of 30 to 60 seconds and further includes the limitation of “said 1,3-dibromo-5,5-dimethylhydantoin is at least 45 ppm when said contact time is 60 seconds and is in the range of 45 to 75 ppm when said contact time is in the range of 30 to 60 seconds.” Support for this added claim may be found at least in Table 4 of the Specification. In addition, support for the addition of Claims 66 and 67 may be found at least in paragraph [0018] of the Specification and support for the addition of Claims 68 and 69 may be found at least in paragraph [0024] of the Specification.

The case is now believed to be in condition for allowance. Further and favorable action is solicited.

If matters remain requiring further consideration that may be expedited by discussion, the Examiner is requested to telephone the undersigned at the number given below so that such matters may be discussed and, if possible, promptly resolved.

Please continue to address all correspondence in this Application to Mr. Edgar E. Spielman, Jr., at the address of record.

Respectfully submitted,

/Jeffrey D. Frantz/

Jeffrey D. Frantz
Reg. No. 56,189
Sieberth & Patty, LLC
4703 Bluebonnet Blvd.
Baton Rouge, LA 70809

Phone: (225) 291-4600
Fax: (225) 291-4606